

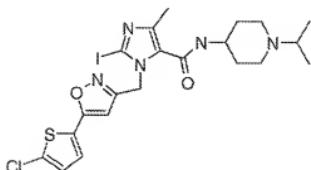
REMARKS

The Examiner's non-final Office Action dated August 22, 2006, has been carefully considered. In the present application, claims 1 and 8-18 are pending. Claims 13 and 15-17 are withdrawn from consideration subject to a Restriction Requirement. Claims 1, 8-12, 14 and 18 are objected. In view of the following remarks, reconsideration and withdrawal of the present basis for objecting to the claims herein of this application is respectfully requested.

Discussion of the Objection to Claims 1, 8-12, 14 and 18

Claims 1, 8-12, 14 and 18 are objected to for allegedly containing non-elected subject matter. Specifically, the Examiner states that:

"In addition to the election of group I, Applicants also elects the following species:



wherein in formula I, R⁹ is substituted isoxazol-3-yl, R1 is H, R2 and G are direct bond, R3 is methyl, R4 is I, Q is methylene, V is piperadine, and M is isopropyl. Therefore, claims 1, 8-12, 14, 18 are being examined in part subject to the election made by applicant.

Examination of the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification results in the following:

In formula I, R1, R2, R3, R4, V, G and M are as defined in claim 1, Q is methylene, R0 is substituted isoxazol-3-yl, the substituents on the imidazole ring are attached to it as in the elected species. As a result of the election and the corresponding scope of the invention identified herein, the remaining subject matter of claims 1, 8-12, 14, 18 are withdrawn from further consideration by the Examiner, under 37 CFR § 1.142(b), as being drawn to a non-elected subject matter. The withdrawn compounds are patentably distinct from the examined invention as they differ in structure and element and would require a separate search. In addition, a reference, which anticipates the examined invention, would not render obvious the non-examined subject matter.

Claims 1, 8-12, 14, 18 are objected to for containing non-elected subject matter. To place the claims in condition for allowance, the claims must be amended within the scope of allowable subject matter set forth above under Status of Claims." (See the Action, pages 2-3).

Applicants respectfully traverse the instant objection.

Applicants respectfully submit that the Examiner's definition of the scope of the elected subject matter is improper. MPEP § 803.02 states that:

"A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to the examination on the merits. The provisional election should be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

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should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush type claims will be extended. If the prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a *non-elected species*, the Markush-type claim shall be rejected to the nonelected species held withdrawn from further consideration" (emphasis added)

In the instant case, Applicants' provisional Election of Species merely provided the Examiner a starting point to perform the search. It is not a basis for the Examiner to restrict the scope of the search or the scope of the Markush-type claim, claims 1-8, 12, 14 and 18. As no prior art was found that anticipated or rendered obvious the elected species, the Examiner's search should be extended until prior art is found that would anticipate or render obvious claims 1, 8-12, 14 and 18 with respect to a non-elected species. Here, the Examiner indicates that the elected species and the above-defined elected subject matter are allowable, i.e., no prior art was found that anticipated or rendered obvious the above-defined elected subject matter. Thus, the Examiner should further extend the search until prior art is found that anticipates or renders obvious a non-elected species. Accordingly, Applicants respectfully request that the Examiner perform a search on the non-elected subject matter as required pursuant to MPEP § 803.02, and further request reconsideration and withdrawal of the instant objection to claims 1, 8-12, 14 and 18.

Conclusion

If there are any issues that can be resolved by a telephone conference or an Examiner's amendment, the Examiner is invited to call the undersigned attorney at (908) 231-3582.

Respectfully submitted,


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